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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,157	12/07/2005	Jean-Jacques Bourguignon		5191

26345 7590 12/01/2008
GIBBONS P.C.
ONE GATEWAY CENTER
NEWARK, NJ 07102

EXAMINER

KIFLE, BRUCK

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

12/01/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

thibbits@gibbonslaw.com
abriggs@gibbonslaw.com
IPDocket@gibbonslaw.com

Office Action Summary

Application No.

10/533,157

Applicant(s)

BOURGUIGNON ET AL.

Examiner

Bruck Kifle

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-49 and 55-58 is/are pending in the application.
- 4a) Of the above claim(s) 37-49, 55 and 57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56 is/are rejected.
- 7) ☒ Claim(s) 58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claims 37-49 and 55-58 are pending in this application.

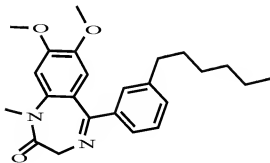
Election/Restrictions

Applicant's election with traverse of the species of claim 58 in the reply filed on 08/19/08 is acknowledged. The traversal is on the ground that the election of species requirement is not according to the rules. This is not found persuasive because the search and examination of the claims places burden on the office and because this election of species requirement is for search purposes.

The requirement is still deemed proper and is therefore made FINAL.

Claims 39-41 and 48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected subject matter.

The elected species has the structure



The elected compound was not found in the search and the search was expanded to embrace the entire scope of formula (1) as claimed in claim 56.

Claim Rejections - 35 USC § 112

Claim 56 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "and pharmaceutically acceptable salts thereof" is improper Markush

language. Appropriate language, such as, "or a pharmaceutically acceptable salt thereof" is suggested to present what is claimed in alternative form.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

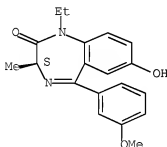
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 56 is rejected under 35 U.S.C. 102(b) as being anticipated by Plunkett et al. (Journal of the American Chemical Society (1995), 117(11), 3306-7). The claim reads on compounds 10b and 10f of the reference. See page 3307. These compounds are depicted below for Applicant's convenience. Claims 37, 38, 43 and 44 would also be anticipated.

RN 165056-86-0 CAPLUS

CN 2H-1,4-Benzodiazepin-2-one, 1-ethyl-1,3-dihydro-7-hydroxy-5-(3-methoxyphenyl)-3-methyl-, (S)- (9CI) (CA INDEX NAME)

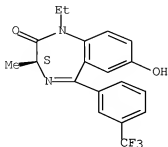
Absolute stereochemistry.



RN 165056-90-6 CAPLUS

CN 2H-1,4-Benzodiazepin-2-one, 1-ethyl-1,3-dihydro-7-hydroxy-3-methyl-5-[3-(trifluoromethyl)phenyl]-, (S)- (9CI) (CA INDEX NAME)

Absolute stereochemistry.



Claims 37, 38, 42-47, 48, 55 and 57 are withdrawn from consideration because art was found (see MPEP 803.02.)

Applicants are advised of MPEP 803.02 Restriction - Markush Claims [R - 2], fourth and fifth paragraph, where is stated:

“As an example, in the case of an application with a Markush - type claim drawn to the compound C - R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush - type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush - type claim and claims to the elected species shall be rejected, and claims to the non - elected species would be held withdrawn from further consideration. As in the prevailing practice, **a second action on the rejected claims would be made final.**” (emphasis added).

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is found that anticipates or renders obvious the Markush-type claim with respect to a non-elected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

Claim 58 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is 571-272-0668. The examiner can normally be reached on Mondays-Fridays from 8:30 AM -6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruck Kifle/
Primary Examiner
Art Unit 1624

BK
November 21, 2008